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EXAMINER

GANEY, STEVEN J

ART UNIT

PAPER NUMBER

3752

DATE MAILED: 07/01/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/807,817

Applicant(s)

MACDONALD, ET AL.

Examiner

Steven J. Ganey

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 March 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-65 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-65 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 12/2/04 & 6/9/05.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Claim Objections

1. Claims 14, 45 and 46 are objected to because of the following informalities: In claims 14 and 45, line 1, the word “devices” should be changed to --device is-- to clearly define the invention. In claim 46, line 1, the word “deviceis” should be changed to --device is-- to correct a typographical error. Appropriate correction is required.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 15, 32, 47 and 63 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The specification is silent to an embodiment where the fastening device is provided with a clip or includes a clip. According to the specification the fastening device is a clip, there is no description of an additional clip on the fastening device. The lack of an art rejection does not indicate allowability of the claims.

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

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The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 1-65 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1, 18, 34, and 50 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential structural cooperative relationships of elements, such omission amounting to a gap between the necessary structural connections. See MPEP § 2172.01. The omitted structural cooperative relationships are between the fastening device and the leg in claims 1 and 18 and between the fastening device and the plate and sleeve in claims 34 and 50.

In claims 16, 33, 48 and 64, there is an inconsistency between the language in the preamble, which recite a support system or method of removably attaching a fire-protection sprinkler support system, and body of the claims which also positively recite “a second end attached to a building component”. This makes the scope of the claims unclear since they appear to be reciting the subcombination of the support system or method of removably attaching a fire-protection sprinkler support system, however, the limitation concerning the combination with the building component is also positively recited. Applicant is required to clarify whether claims 16, 33, 48 and 64 are drawn to the subcombination or the combination and to amend the claims to be consistent with the intent. As to treating the claims on the merits, the examiner is considering the claims to be drawn to the subcombination of the support system or method of removably attaching a fire-protection sprinkler support system.

Claim 19, line 1, the recitation of “a tongue” raises double inclusion issues and is indefinite since “a first portion” recited in line 7 of claim 18 is also considered the tongue.

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In claim 34, line 5, the recitation of the "fastening device configured to removably attach the sprinkler support system to a T-bar grid" is indefinite since as disclosed the fastening device is configured to removably attach the plate and sleeve to a T-bar grid. The fastening device is part of the support system, not a separate element from the support system.

In claim 50, line 6, the recitation of "providing a fastening device configured to removably attach the sprinkler support system to the T-bar grid" is indefinite since as disclosed it configured to removably attach the plate and sleeve to the T-bar grid. The plate and sleeve and fastening device are part of the support system, not separate elements from the support system. There should be a step defining the support system comprising the plate and sleeve and fastening device.

Double Patenting

6. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

7. Claims 1-3, 6, 7, 9, 11, 12, 15, 18-20, 29, 32, 34-36, 43 and 44 rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-6, 23 and 24 of U.S. Patent No. 6,752,218. Although the conflicting claims are not identical, they are not patentably distinct from each other because they both claim a hub, a leg

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and a fastening device to attach the support system to a T-bar grid. It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the fastening device as claimed in the instant invention, since the fastening device of U.S. Patent No. 6,752,218 is fully supported by the disclosure and meets the claims in the instant invention.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 1-7, 9, 12, 13, 16-24, 26, 29, 30, 32 and 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hubbard in view of Laughlin et al.

Hubbard shows a fire-protection sprinkler support system comprising a hub comprising a plate 24 and sleeve 28; a leg 20/22; a sprinkler assemblage comprising a conduit 14, a fitting 12 and sprinkler 16; and a fastening device 42/46 for attaching to a T-bar grid, except for the fastening device comprising a first portion having a generally vertically extending sidewall, second portion spaced by a gap from the first portion, and an upper attachment portion as claimed. Laughlin et al shows a support system comprising a leg 50 with fastening devices comprising a first portion 64/65; a second portion 66/67 and protruding portions 72/73 and 78/79 which can be attached to a T-bar grid. It would have been obvious to one having ordinary skill in the art at the time the invention was made to substitute the fastening device of Laughlin et al for the fastening device Hubbard since such a modification would amount to the mere

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substitution of one functional equivalent fastening device for another within the same art and the selection of any of fastening devices would work equally well in the Hubbard device. Also, the Laughlin et al fastening device would reduce the number of working parts and would facilitate moving the support system along the T-bar grid without having to undo the clamping screw as in Hubbard.

As to claims 4 and 21, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have a second leg since such a modification is merely the duplication of essential working parts of a device and involves only routine skill in the art. In addition a second leg would provide further stability and further prevent rotation of the support.

As to claims 6 and 23, the hub of Hubbard could be designed to define a circular opening as a matter of obvious design choice and would work equally as well with either an annular opening as shown or a circular opening.

As to claims 12 and 29, it is well known in the fire protection industry to use flexible conduit for facilitating the installation of sprinkler systems and would require only routine skill in the art to provide such an arrangement.

As to claims 14 and 31, the fastening devices of Hubbard, as modified by Laughlin et al, could be designed to remain fastened to the T-bar grid during a seismic event measuring 3.5 or greater on the Richter scale as a matter of design choice depending on where the support system would be used in different parts of the country and in order to conform to the governing building codes.

As to claims 16, 17 and 33, it would have been obvious to one having ordinary skill in the art at the time the invention was made to provide a rod attached to the hub and a second end

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attachable to a building component, since such equipment is used throughout the fire protection industry for supporting various piping arrangements and would require only routine skill in the art. In addition it would provide additional securing means for the support system.

Allowable Subject Matter

10. Claims 8, 10, 25, 27, 28, 37-42 and 45-49 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

11. Claims 50-65 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action.

Conclusion

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steven J. Ganey whose telephone number is (571) 272-4899. The examiner can normally be reached on Monday, Tuesday, Thursday and Friday from 8:00 AM to 5:30 PM.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dave Scherbel, can be reached on (571) 272-4919. The fax phone number for this Group is (703) 872-9306.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-1113.

sjg

6/23/05


STEVEN J. GANEY
PRIMARY EXAMINER
6/23/05